

REMARKS

This application pertains to a novel method for the mechanical protection of painted plastic mounted parts of automobiles.

Claims 3-21 are pending; Claim 1 being cancelled by this amendment.

Claim 15 and 16 have been amended to independent form, and all of the other claims depend therefrom.

Applicants' claims are directed to a novel method for protecting the curved surfaces on the outside of automobiles, and the paint finish of plastic automobile parts, by covering them with a self-adhesive article comprising a film-form material having a Young's modulus of less than 300 N/mm² laminated with a layer of knitted fabric.

This combination of this knitted fabric and a film having a Young's modulus of less than 300 N/mm² produces an article that can be applied to curved surfaces with little creasing. The novel article is characterized by excellent resistance to frictional loads and minor impacts, exceeding that of a woven fabric of analogous basis weight.

More specifically, Applicants' claims are directed to:

A method for the mechanical protection of curved surfaces of automobiles, by applying to said curved surfaces a protective sheet or article, which is comprised of:

- a backing film having a Young's modulus of less than 300 N/mm²,

- a knitted fabric laminated to one side of the backing film, and
- a self-adhesive composition on the other side of the backing film.

Claims 1 and 3-21 (now 3-21) stand rejected under 35 USC 103(a) as obvious over Inoue (EP 0 959 119 A) in view of Gobran (US 5,547,766) and further in view of Kollaja et. al. (US 6,436,531).

The Examiner sees Inoue as disclosing a **masking tape** for automobiles, having a **non-woven** top layer on a polymer substrate with a PSA bottom coating. Gobran, on the other hand, is viewed by the Examiner as teaching that knit, woven and non-woven layers can be used on top of "the" polymer substrate. From Gobran, the **Examiner reaches the conclusion** (which is neither taught nor suggested by Gobran) that knit and woven layers are equivalent to a non-woven layer, and that therefore it would be obvious to substitute a knit layer for Inoue's non-woven. Then, because Applicants previously pointed out that both Inoue and Gobran exemplify their inventions with **polypropylene** films (known to be strongly crystalline and correspondingly hard; cannot meet the Young's modulus requirement), the Examiner now reaches out for the Kollaja reference, for a film made of blended polymers, to make it flexible.

In this, the Examiner is clearly engaging in hindsight reconstruction, reaching out into the art to find bits and pieces from which he can attempt to reconstruct Applicants' protective article and method, in the total absence of anything in the art to suggest such a reconstruction.

Specifically, Inoue teaches a sheet comprised of **nonwoven** support laminated to a polymer film, and a pressure-sensitive adhesive layer formed on one surface of the polymer film. Inoue has **specific reasons** for using a nonwoven support. At page 1, lined 11-12, Inoue teaches that the nonwoven support has "a high flexibility and appropriate stretch tolerance", and at lines 15-16 he teaches that his protective sheet sustains "the above mentioned follow-up performance". Thus, the nonwoven has special properties that enable Inoue to accomplish his objectives. Nowhere is there to be found any suggestion that any other material will do this.

Gobran, on the other hand, is concerned **only** with making polypropylene film based adhesive tapes non-yellowing. Gobran mentions that various types of polypropylene-film based adhesive tapes can be made non-yellowing by his invention, and mentions that one face of such polypropylene films of such adhesive tapes can be covered with a fibrous web layer, such as a nonwoven web, knitted web, stitch-bonded web, or a woven web or the like (Col 1, lines 63-66). In this regard, all Gobran does is **acknowledge the existence** of such various types of adhesive tapes; and never ever does Gobran even remotely suggest that such types are in any way **equivalent**. The Examiner, in arguing that Gobran teaches "that these are equivalent reinforcing layers in adhesive tapes" (office action, page 3, lines 13-15); is attributing something to Gobran that is not there, and making a pronouncement that, frankly, would be rejected by any and every person skilled in this art. No person having any degree of skill in this art would ever believe or suggest that a nonwoven web, a knitted web, a stitch-bonded web and a woven web were "**equivalent**" to each other. This is especially true in view of the special attributes relied on by Inoue in using a nonwoven for his invention.

The Examiner's argument for taking a knitted web from Gobran and substituting it for the nonwoven of Inoue is absolutely unsupported by anything that could be read into either reference and, in essence, amounts to a statement that it would be used because "it is there". The mere fact that knitted webs were known, does not provide any basis for discarding the nonwoven, which was chosen by Inoue for its special properties, and substituting a knitted web for it.

It also should not escape the Examiner's attention that Gobran is concerned with **adhesive tapes**, and has nothing to do with a method of protecting the surfaces of automobiles.

The Kollaja reference, on the other hand, is concerned with flexible films and tapes **useful for applications involving elevated temperatures**, such as auto paint masking applications **on substrates exposed to elevated temperatures** (col. 2, lines 35-36). Kollaja's films are desirably heat resistant (col. 7, first three paragraphs). Here again, there is no suggestion in any of the references to substitute Kollaja's polymer film for Inoue's. The mere fact that Kollaja's film exists does not provide any reason why it should be substituted for Inoue's.

In proposing to substitute a knitted web mentioned in Gobran for Inoue's nonwoven, and at the same time substituting Kollaja's polymer film for Inoue's, the Examiner would modify Inoue's teaching simply because he has been able to find the elements he thinks he can use to reconfigure Inoue's invention to somehow convert it into Applicant's invention. There is, however, nothing to be found anywhere in any of the references that would lead

those skilled in the art to do this, in the absence of having first read Applicant's disclosure and then attempting to reconstruct it.

It is respectfully pointed out that the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Nothing in this combination of references suggests the desirability of the modifications suggested by the Examiner.

Applicants' invention cannot realistically be seen as obvious over the Inoue, Gobran and Kollaja references.

The rejection of Claims 2 and 3-21 (now 3-21) under 35 USC 103(a) as obvious over Inoue in view of Gobran and further in view of Kollaja should accordingly now be withdrawn.

In view of the present amendments and remarks it is believed that Claims 3-21 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, applicant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account

No. 14-1263.


ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit

Account No. 14-1263.


Respectfully submitted

NORRIS, McLAUGHLIN & MARCUS

By 
William C. Gerstenzang
Reg. No. 27,552

WCG/tmh
220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

I hereby certify that this correspondence is being transmitted via facsimile, no. 703-872-9310 to the United States Patent and Trademark Office, addressed to: Mail Stop Non-Fee Amendment, Hon. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 18, 2004.

By 
William C. Gerstenzang
Date March 18, 2004